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### III. REMARKS

Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

#### 1. Status of the Claims

Claims 1-46 were pending in this application. Claims 34-38, 40-43 and 46 have been canceled. Accordingly, Claims 1-33, 39 and 44-45 are pending for examination on the merits.

#### 2. Summary of the Amendments

Claims 34-38, 40-43 and 46 have been canceled without prejudice or disclaimer. Additionally, Claim 39 has been amended to replace "Claims 1 to 33" with "Claims 1-33." Entry of these amendments is respectfully requested.

#### 3. Restriction Requirement

Applicants acknowledge that the restriction requirement for Groups I/II and III/IV has been made Final. Applicants respectfully disagree with this decision for at least the reasons stated in the response filed on March 28, 2006. Accordingly, Applicants are filing herewith a petition to the Director for reconsideration of this decision.

#### 4. Claim Objections

Claim 39 has been objected to under 37 C.F.R. §1.75(c) as being in improper form because it allegedly does not refer to other claims in the alternative only. For the following reasons, this objection may be withdrawn.

As originally presented, Claim 39 recited, in part, "a compound of any one of Claims 1 to 33." While Applicants believe this language meets the requirements of 37 C.F.R. §1.75(c), Applicants have amended Claim 39 to recite, in part, "a compound of any one of Claims 1-33", i.e., "Claims 1 to 33" has been replaced with "Claims 1-33."

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Thus, the format of Claim 39 is now entirely consistent with the acceptable multiple dependent claim wording examples set forth in MPEP §608.01(n). Accordingly, this objection may be withdrawn.

5. Rejections Under 35 U.S.C. §112, Second Paragraph

Claims 34-38 and 40 have been rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. While not agreeing with the Examiner, Claims 34-38 and 40 have been canceled and therefore, this rejection may be withdrawn.

6. Rejections Under 35 U.S.C. §112, First Paragraph

Claim 40, 41 and 43 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. While not agreeing with the Examiner, Claims 40, 41 and 43 have been canceled and therefore, this rejection may be withdrawn.

7. Obviousness-Type Double Patenting

Claims 44-46 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 33-35 of U.S. Patent Application No. 10/888,855. Additionally, Claims 1-6, 13-33, 39-41 and 43 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 8, 9, 12-15 and 20 of U.S. Patent Application No. 10/975,657 in view of Claims 1-6, 13-22 and 28-32 of U.S. Patent Application No. 10/888,855. Claims 7-12, 30, 39-41 and 43 have also been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 8, 9, 12-15 and 20 of U.S. Patent Application No. 10/975,657 in view of Claims 7-13, and 28-32 of U.S. Patent Application No. 10/888,855. For the following reasons, Applicants respectfully request that these rejections be withdrawn.

M.P.E.P. 804(I)(B)(1) states that "[i]f a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed

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of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer."

In the present case, the present application has an effective filing date of October 29, 2003; U.S. Patent Application No. 10/888,855 has an effective filing date of July 9, 2004; and U.S. Patent Application No. 10/975,657 has an effective filing date of October 28, 2004. Therefore, the present application is the earlier-filed application.


In view of the present amendments and remarks, Applicants respectfully submit that the present obviousness-type double patenting rejections over U.S. Patent Application Nos. 10/888,855 and 10/975,657 are the only remaining rejections in this application. According, pursuant to M.P.E.P. 804(I)(B)(1), Applicants respectfully request that the Examiner withdraw these rejections and permit the present, earlier-filed application to issue as a patent without a terminal disclaimer.

#### IV. CONCLUSION

Reconsideration of this application in view of the above amendments and remarks is respectfully requested. Should there be any questions regarding this paper or this application, or if the Examiner believes any issues can be resolved by telephone, Examiner is encouraged to call the undersigned attorney for Applicants at (650) 808-6406.

Respectfully submitted,  
THERAVANCE, INC.

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